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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

In re application of Donald J. Boulia
Serial Nbr: 09/619,178
Filed: July 19, 2000
For: Technique for Sending TCP Messages through HTTP Systems
Art Unit: 2155
Examiner: Oanh L. Duong

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APPELLANT'S REPLY BRIEF

This Reply Brief is submitted in furtherance of the Appeal Brief that was filed in this case on July 19, 2005, and responds to the Examiner's Answer dated November 29, 2006.

ARGUMENTS

1. Appellant's Appeal Brief dated July 19, 2005 (hereinafter, "Appellant's Appeal Brief") discusses two grounds of rejection, involving 35 U.S.C. §103(a) rejections that cite U. S. Patent 6,412,009 to Erickson et al. (hereinafter, "Erickson") and U. S. Patent 6,442,590 to Inala et al. (hereinafter, "Inala").
2. This Reply Brief responds to the Examiner's Answer dated November 29, 2006 (hereinafter, "the Examiner's Answer"). For purposes of this Reply Brief, Appellant respectfully submits arguments, herein, discussing the 35 U.S.C. §103(a) rejection of Claims 1 - 4, 6 - 13, 15 - 22, 24 - 29, and 31 as being obvious in view of Erickson and Inala.
3. Section 706.02(j) of the MPEP, "Contents of a 35 U.S.C. 103 Rejection", states the requirements for establishing a *prima facie* case of obviousness under this statute, noting that three criteria must be met. These criteria are (1) a suggestion or motivation, found either in the references or in the knowledge generally available, to modify or combine the references; (2) a reasonable expectation of success; and (3) the combination must teach or suggest all the claim limitations. This text goes on to state that "The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done.". The three requirements for establishing a *prima facie* case of obviousness are also stated in MPEP §2142, "Legal Concept of *Prima Facie* Obviousness", and MPEP §2143, "Basic Requirements of a *Prima Facie* Case of Obviousness".

4. Section 1207.02(A)(9)(d)(iii) of the Manual of Patent Examining Procedure (“MPEP”) states that the Examiner’s Answer, when discussing a rejection under 35 U.S.C. 103, must explain “why it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified the primary reference to arrive at the claimed subject matter”.

5. With regard to limitations on lines 8 - 9 of Appellant’s independent Claim 1 (which claim language specifies “wherein the receive channel is distinct from the send channel”), p. 5, lines 7 - 8 of the Examiner’s Answer admits that Erickson “does not explicitly teach the receive channel is distinct from the send channel”. Appellant agrees that Erickson does not teach this limitation. See paragraphs 15 - 21 of Appellant’s Appeal Brief, where it is noted that Erickson explicitly teaches use of a single tunnel/connection for both sending and receiving, and where citations are provided to support this assertion of Appellant.

6. Continuing at p. 5, lines 13 - 20, the Examiner’s Answer presents the supposed motivation for combining Erickson and Inala to thereby render Appellant’s Claim 1 obvious, stating

It would have been obvious ... [to] incorporate the receive channel is distinct from the send channel ... One would be motivated to do so to improve the efficiency of transmission in term [sic] of cost (i.e., less hardware and cost associated therewith may be required to support one-way communication, as contrasted with two-way communication) and simplicity (i.e., one-way communication is often easier to establish than two-way communication) required for the connections. (emphasis added)

7. Appellant respectfully submits that this supposed motivation to combine the references is flawed, for several reasons, as will now be discussed.

8. First, Appellant respectfully submits that the amount of hardware, and cost thereof, is not lessened by his claimed invention. Accordingly, Appellant respectfully submits that “less hardware and cost associated therewith” is a mere assertion of the Examiner, and an assertion that is not supported by the references.

9. See lines 4 - 6 of Appellant’s Claim 1, discussing Appellant’s send channel, and lines 7 - 9 of Claim 1, discussing the receive channel. Each of these channels is established between a “first component on a client side of a network” and “a second component on a remote side of the network”. In addition, each of these channels is established “through one or more HTTP-based systems”. In contrast to the assertion in the Examiner’s Answer, using a send channel for transmitting “client-initiated TCP requests” (Claim 1, lines 14 - 16) and using a distinct receive channel for transmitting “server-initiated TCP requests” (Claim 1, lines 17 - 19) does not, in any way, require “less hardware” than using a single bi-directional transmission channel. In fact, one of skill in the art will realize that more resources may be required to establish two distinct channels (i.e., Appellant’s send and receive channels) instead of using a single channel/connection as in Erickson.

10. Second, Appellant respectfully submits that it is a mere assertion of the Examiner that “the efficiency of transmission in terms of cost” (emphasis added) would be improved by providing a send channel that is distinct from a receive channel. Since the two (uni-directional) channels established by Appellant’s technique generally carry the same message traffic as Erickson’s single bi-directional connection, there is generally no gain in throughput to be achieved by using distinct

channels. Accordingly, in contrast to the assertion in the Examiner's Answer, using two distinct channels does not appear to provide improved efficiency of transmission.

11. In the alternative, Appellant respectfully requests that the Examiner point to some teaching in the prior art which supports this assertion of 'improved efficiency of transmission', or provide an Examiner's Affidavit in support thereof.

12. Finally, Appellant respectfully submits that it is a mere assertion of the Examiner that "one-way communication is often easier to establish than two-way communication" (emphasis added). Appellant respectfully requests that the Examiner point to some teaching in the prior art which supports this assertion, or provide an Examiner's Affidavit in support thereof.

13. In view of the above, Appellant respectfully submits that a *prima facie* case of obviousness has not been made out as to independent Claim 1, because the motivation to combine the references is defective for the reasons presented above in paragraphs 3 - 12. Accordingly, the requirements for a *prima facie* case (as noted above in paragraphs 3 - 4) have not been met. Without more, Claim 1 is deemed patentable. (See *In re Oetiker*, discussed in paragraph 35 of Appellant's Appeal Brief.)

14. Other independent claims in the subject application are Claims 10 and 19 (which are system and method claims comprising limitations which are analogous to those of the method in Claim 1) and Claims 28 and 31. Each of these independent claims specifies "wherein the receive

channel is distinct from the send channel”. The analysis of these other independent claims in the Examiner’s Answer will now be discussed (see paragraphs 15 - 17, below), with regard to the motivation to combine the references.

15. Claims 10 and 19 are discussed in the Examiner’s Answer on p. 8, lines 4 - 5 and on p. 10, lines 3 - 4, respectively. As stated therein by the Examiner, these claims are rejected for similar reasons as Claim 1. Accordingly, Appellant respectfully submits that a *prima facie* case of obviousness has not been made out as to independent Claims 10 and 19, because the motivation to combine the references is defective for the same reasons discussed above in paragraphs 3 - 12.

16. Independent Claim 28 is discussed in the Examiner’s Answer on p. 10, lines 13 - 14. As stated therein by the Examiner, this claim is rejected for similar reasons as Claim 1. Accordingly, Appellant respectfully submits that a *prima facie* case of obviousness has not been made out as to independent Claim 28, because the motivation to combine the references is defective for the same reasons discussed above in paragraphs 3 - 12.

17. With regard to independent Claim 31, the Examiner’s Answer admits that Erickson “does not explicitly teach the receive channel is distinct from the send channel” (Examiner’s Answer, p. 13, lines 3 - 4). The same supposed motivation quoted herein in paragraph 6 for combining Inala with Erickson is then presented on p. 13, lines 9 - 16 of the Examiner’s Answer. Appellant respectfully submits that a *prima facie* case of obviousness has not been made out as to independent Claim 31, because the motivation to combine the references is defective for the same

reasons discussed above in paragraphs 3 - 12.

18. Appellant also respectfully submits that the fifth and sixth elements of his independent Claims 1, 10, 19, 28, and 31 have not been properly analyzed. These claim elements are discussed in paragraph **(B)** on pages 18 - 19 of the Examiner's Answer, where the Examiner states that the "broadest reasonable interpretation" has been given to this claim language. Appellant respectfully submits that this interpretation ignores explicit limitations of Appellant's claim language, and is therefore improper, as will now be discussed (see paragraph 19, below).

19. Appellant respectfully notes that the fifth claim element (in each independent claim) pertains to transmitting client-initiated requests on the send channel, and that the sixth claim element (in each independent claim) pertains to transmitting server-initiated requests on the receive channel. (See, for example, lines 14 - 16 and lines 17 - 19, respectively, of Claim 1.) Each of Appellant's independent claims specifies that the send channel is distinct from the receive channel. Accordingly, by citing the same, single channel/connection of Erickson as teaching both the fifth and sixth claim elements of Appellant's independent claims, the Examiner is using the same connection from Erickson (1) for teaching the send channel and (2) for teaching the receive channel – even while admitting that Erickson does not teach Appellant's claimed limitation that these channels are distinct. In other words, by citing this single connection for both of Appellant's fifth and sixth claim elements, the Examiner is contending (1) that Erickson's single connection is a send channel that is distinct from a receive channel (fifth claim element), and then (2) that Erickson's single connection is a receive channel that is distinct from a send channel (sixth

claim element).

20. Paragraph **(C)** on pages 19 - 20 of the Examiner's Answer discusses a motivation for "introduc[ing] multiple connections into Erickson's disclosed teachings". This paragraph of the Examiner's Answer concludes with a statement of the same supposed motivation that was cited above in paragraph 6. As demonstrated above in paragraphs 7 - 12, this supposed motivation is defective.

21. Paragraph **(D)** on pages 20 - 21 of the Examiner's Answer discusses hindsight motivation for locating Inala's teachings. This paragraph of the Examiner's Answer concludes with a statement of the same supposed motivation that was cited above in paragraph 6. As demonstrated above in paragraphs 7 - 12, this supposed motivation is defective.

22. Accordingly, Appellant maintains his position that Erickson and Inala do not teach all elements of his claimed invention, and that a *prima facie* case of obviousness under 35 U. S. C. §103 has not been made out.

CONCLUSION

In view of the above, Appellant respectfully submits that the rejection of appealed Claims 1 - 31 is overcome. Accordingly, it is respectfully urged that the rejection of appealed Claims 1 - 31 not be sustained.

Respectfully submitted,

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